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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Hiroaki Harada

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EXAMINER

RAPILLO, KRISTINE K

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/910,716	<b>Applicant(s)</b> HARADA ET AL.	
	<b>Examiner</b> KRISTINE K. RAPILLO	<b>Art Unit</b> 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12/18/2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-5, 10, 11 and 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-5, 10-11 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/13/2009; 8/5/2009</u> .                                     | 6) <input type="checkbox"/> Other: _____                          |

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## **DETAILED ACTION**

### ***Notice to Applicant***

1. This communication is in response to an amendment submitted December 18, 2009. Claims 21 - 22 are canceled (Claims 1, 6 - 9, and 12 - 19 were previously canceled). Claims 4, 10 11, and 20 are amended. Claims 2 - 5, 10 - 11 and 20 are presented for examination.

### ***Specification***

2. The objection to the disclosure is withdrawn based upon the amendment submitted December 18, 2009.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2 - 5, 10 - 11, and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. With regard to claim 1, the following limitations are rejected as being vague and indefinite:

- “cross-checking, by a server operated by a service dealer.....” is unclear. It is unclear whether the cross-checking performed by the server or the operator.
- The phrase “judging whether the solicitation-related keyword ....” is condition; the claims allows the options of found the keyword or has not found the keyword. For the purpose of examination, the claim will be treated as the keyword has not been found. In addition, it is unclear who or what is performing the step of judging.
- The limitation “selecting at least one insurer from a plurality of insurers based on registered information that satisfies a providing condition of a trading price and a transaction type indicating whether the transaction is either an auction or a trading included in the electronic information” is

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unclear. It is unclear how it is known that an auction or trading transaction is included in the distributed information and what Applicant intended by this limitation.

- The limitation “wherein the selecting comprises referencing a definition table that defines providing conditions in accordance with trading prices and transaction types” is unclear. It is unclear if referencing a definition table actually performs a function as it does not pull data from the table, it appears the limitation only refers to looking (i.e. referencing) at the information.

6. With regard to claim 3, the Applicant recites “if the insurance is invalid, or if the buyer....” and “if the insurance is invalid, or if the seller.....”. It is unclear what happens when the “if” statements are false.

7. With regard to claim 5, the term “normal” is subjective; what is normal for one, may not be normal for another. In addition, the phrase “based on a discount insurance” is unclear; The Applicant has not clearly claimed what the phrase “based on a discount insurance” refers to, for instance, trading price or final insurance premium.

### ***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 2 – 5 and 20 are rejected under 35 U.S.C. 101 because claims 2 – 5 and 20 are directed to a method. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office’s guidance to an examiner is that a USC §101 process must (1) be tied to a particular machine or apparatus or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. . *In re Bilski et al*, 88 USPQ 2d 1385 CAFC (2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

To qualify as a USC §101 statutory process, the claim should recite the particular machine or apparatus to which it is tied, for example by identifying the machine or apparatus that accomplishes the

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method steps, or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

There are two corollaries to the machine-or-transformation test. First, a mere field of use limitation is generally insufficient to render an otherwise ineligible method claim patent eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such as data gathering or outputting, is not sufficient to pass the test.

Here, Applicant's method steps fail the first prong of the new test because they are not tied to a particular machine. Further, Applicant's method steps fail the second prong of the test because no underlying subject matter has been transformed.

Although the Applicant has claimed cross-checking by a server, it appears the main point of the invention is to select at least one insurer from a plurality of insurers that satisfies a providing condition of a trading price and a transaction type; this limitation is not tied to a particular machine.

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 4, 10, and 1 are rejected under 35 U.S.C. 103(a) as being unpatentable over DiMattina, (U.S. Patent No. 6,405,177) in view of Furusawa et al., herein after Furusawa (U.S. Patent No. 6,934,738).

In regard to claim 4 (CURRENTLY AMENDED), DiMattina teaches an insurance task processing method comprising:

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cross-checking, by a server operated by a service dealer other than a buyer, a seller and an insurer, electronic information king, by a distributed within the server between the buyer and the seller with a word table in which a solicitation-related keyword is registered (Figures 1, 3, and 4; column 2, lines 57 – 63; column 3, lines 56 – 62 and column 4, lines 12 – 14) where the Examiner interprets the data regarding items the purchaser wishes to buy to be a form of a solicitation-related keyword. A form of cross verifying is performed when the purchase price is verified against the item to be purchased.

Furusawa teaches a method comprising judging whether the solicitation-related keyword is included in the electronic information (column 5, lines 21 – 34).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a method comprising crosschecking a solicitation-keyword table to the electronic information; judging whether the solicitation-related keyword is included in the electronic information; and distributing the solicitation-to-insurance information of each selected insurer as taught by Furusawa, within the method of DiMattina, with the motivation of providing uniformity in message processing (column 1, lines 37 -42)

With regard to claims 2, 3, and 5: These claims are not performed, therefore are not limiting. Citations are not required.

Computer Readable Medium, System, and Method claims 10, 11, and 20 respectively, repeat the subject matter of claim 4. As the underlying processes of claim 4 has been shown to be fully disclosed by the teachings of DiMattina in the above rejection of claim 4; as such, these limitations (10, 11, and 20) are rejected for the same reasons given above for claim 4 and incorporated herein.

### ***Response to Arguments***

12. Applicant's arguments filed July 14, 2009 have been fully considered but they are not persuasive. Applicant's arguments will be addressed herein below in the order in which they appear in the response filed July 14, 2009.

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In response to the Applicant's argument, it is respectfully submitted that the Examiner has applied new passages and new citations to the amended claims.

***Conclusion***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to KRISTINE K. RAPILLO whose telephone number is (571)270-3325. The examiner can normally be reached on Monday to Thursday 6:30 am to 3:30 pm Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on 571-272-6787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/K. K. R./  
Examiner, Art Unit 3626  
3/29/10

/Robert Morgan/  
Primary Examiner, Art Unit 3626